

Application No. 10/618,105
Amendment dated January 16, 2008
Reply to Final Office Action of November 16, 2007

Docket No.: NY-KIT 359-US

REMARKS

Claims 7-17 have been withdrawn pursuant to the restriction requirement which has been made final in this office action. Accordingly, claims 1-6 are pending in this application.

Applicants' acknowledge with appreciation that claims 2-4 would be allowable if rewritten in independent form.

Claims 1 and 5-6 have been rejected under 35 U.S.C. § 102(a) as being allegedly anticipated by U.S. Patent 5,493,639 to Hirano et al. (hereinafter "Hirano"). Applicants respectfully traverse this rejection.

A rejection based on 35 U.S.C. §102 requires that the cited reference disclose each and every element covered by the claim. *Electro Medical Systems S.A. v. Cooper Life Sciences Inc.*, 32 U.S.P.Q.2d 1017, 1019 (Fed. Cir. 1994); *Lewmar Marine Inc. v. Barient Inc.*, 3 U.S.P.Q.2d 1766, 1767-68 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1007 (1988); *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q.2D 1051, 1053 (Fed. Cir.), *cert. denied*, 484 U.S. 827 (1987). The Federal Circuit has mandated that 35 U.S.C. 102 requires no less than "complete anticipation ... [a]nticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim." *Connell v. Sears, Roebuck & Co.*, 772 F.2d 1542, 1548, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983); *See also, Electro Medical Systems*, 32 U.S.P.Q. 2d at 1019; *Verdegaal Bros.*, 814 F.2d at 631. Here, the Examiner has failed to establish a case that Hirano is an anticipatory reference under 35 U.S.C. §102(c) because it fails to teach all of the limitations of claims 1, 5 and 6.

Application No. 10/618,105
Amendment dated January 16, 2008
Reply to Final Office Action of November 16, 2007

Docket No.: NY-KIT 359-US

Only the present invention teaches or suggests rotating "the template information according to the posture of the image information so as to cause said reference display posture thereof to correspond to said either posture of the image information when said posture of the image information differs from said reference display posture of the template information, thereby providing optimum template information for synthesizing the image information" as required by claims 1 and 6. Whereas, in fact, col. 1, lines 51-54 cited in Hirano by the Examiner for allegedly disclosing the rotation processing means merely describes rotating the image after the image has been synthesized: "by maintaining the relation between the block and the character string, both the box and the character string can conjointly move at the moment of executing an editing command." That is, the present invention rotates the template information to obtain optimum template information for synthesis, whereas Hirano merely describes rotating the synthesized image as part of the editing process.

Further, Fig. 12 in Hirano, cited by the Examiner, merely shows resizing the character frame (box) 211 to fit all of the characters in a single line. Contrary to the Examiner's assertion, Hirano does not teach or suggest "rotating the template information so as to cause said reference posture thereof to correspond to said either posture of the image information when said posture of the image information differs from said reference display posture of the template information, thereby providing optimum template information for synthesizing the image information," as required in amended claim 1 (and similarly in claim 6). Therefore, Hirano is not an anticipatory reference to the present invention. "To imbue one of ordinary skill in the art with knowledge of the present invention, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim of the insidious effect of hindsight syndrome, wherein that which only the inventor taught is used against the teacher." *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983). Applicant respectfully submits that

Application No. 10/618,105
Amendment dated January 16, 2008
Reply to Final Office Action of November 16, 2007

Docket No.: NY-KIT 359-US

the Examiner cannot use hindsight gleaned from the present invention to modify the clear teaching of the prior art reference to render claims unpatentable. The prior must to be judged based on a full and fair consideration of what that art teaches, not by using Applicant's invention as a blueprint for gathering various bits and modifying the pieces in an attempt to reconstruct Applicant's invention.

Moreover, the execution of the conversion of the template information at the time of the rotation operation advantageously permits the present invention to avoid aesthetic visual imbalance. Additionally, the present invention requires storage of only one direction (vertical or horizontal) of the reference display posture for the template information.

On the basis of the above remarks, reconsideration and allowance of all of the pending claims are respectfully requested.

* * *

Applicants believe no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-0624, under Order No. NY-KIT 359-US (10406391) from which the undersigned is authorized to draw.

Dated: January 16, 2008

Respectfully submitted,

By 

C. Andrew Im

Registration No.: 40,657

FULBRIGHT & JAWORSKI L.L.P.

666 Fifth Avenue

New York, New York 10103

Attorney for Applicants

(212) 318-3000
(212) 318-3400 (Fax)

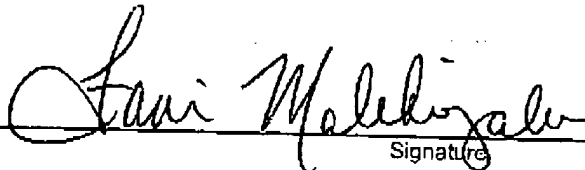
PTO/SB/97 (09-04)
Approved for use through 07/31/2006. OMB 0651-0031
U. S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

Application No. (if known): 10/618,105 Attorney Docket No.: NY-KIT 359-US

Certificate of Transmission under 37 CFR 1.8

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office.

on January 16, 2008
Date


Signature

Fani Malikouzakis
Typed or printed name of person signing Certificate

Registration Number, if applicable

(212) 318-3220
Telephone Number

Note: Each paper must have its own certificate of transmission, or this certificate must identify each submitted paper.

Amendment in Response to Final Office Action (10 pages)

25808621.1

2